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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/556,934

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YAMA3053

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625 SLATERS LANE

FOURTH FLOOR

ALEXANDRIA, VA 22314-1176

EXAMINER

MICALI, JOSEPH

ART UNIT

PAPER NUMBER

1793

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/556,934	Applicant(s) YAMASHITA ET AL.	
	Examiner Joseph V. Micali	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

The amendments/argumentation filed on May 3rd, 2010 have been entered. Claims 1 and 3-9 are pending and presented for examination on the merits, as claim 2 had previously been withdrawn as per applicant's response to the requirement for restriction while claims 6-7, drawn to the loaded paper, have been rejoined based on the petition decision of May 14th, 2010. The previous objection to the specification has been withdrawn as per applicant's amendment.

Election/Restrictions

1. Claims 6-7, the Group III invention drawn to a loaded paper, has been rejoined and the examiner has now been directed to examine both Groups I and III together. This is on the basis on applicant's admission of a lack of patentable distinction between the claims of Group I and those of Group III (See applicant's response to the requirement for restriction of October 15th, 2009, as well as applicant's petition of February 12th, 2010). Thus, as applicant has admitted a lack of patentable distinction between Groups I and III, with an explicit statement that "the claims of group III are obvious variants of those of group I", it necessarily follows that a rejection sufficiently rejecting the group I invention would have to reject the group III invention as well.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 and 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Pub. No. 2000-212892 by Kurata et al in view of Japanese Patent Pub. No. 10-310996 by Nishijima et al, as evidenced by US Patent Pub. No. 2008/0261021 by Haenen et al.

With respect to claims 1 and 3-4, Kurata is drawn to a coated printing paper (**title**). Specifically, such a coating composition is composed of a spindle-shaped precipitated calcium carbonate having average particle diameters of 3.0 to 5.0 microns in a secondary particle shape (**abstract, claim 1**).

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However, Kurata is silent with regards towards the primary particles having a long diameter of 0.5 to 3.0 microns, a short diameter of 0.1 to 1.0 micron, and thus, an aspect ratio of 3 or more.

Nishijima is drawn to the production of coated paper for offset printing (**title**). Specifically, Nishijima discloses a coating composition of needle-like or prism-like precipitated calcium carbonate having a long diameter of 3.0 to 5.0 microns and a short diameter of 0.2 to 0.5 microns (**abstract, claim 1**), and thus, an aspect ratio of 6 or more. **MPEP 2144.05 [R-5]** states that, “In the case where the claimed ranges ‘overlap or lie inside ranges disclosed by the prior art’ a *prima facie* case of obviousness exists.”

At the time of invention it would have been obvious to a person of ordinary skill in the art to produce the product of Kurata including primary particles with specific long and short diameters, in view of the teaching of Nishijima. The suggestion or motivation for doing so would have been to improve the operability and decrease the cost of printing with the use of such a primer coating solution composition (**Nishijima, abstract**).

With respect to claim limitations drawn to BET surface area and pore volume, **MPEP 2112.01 [R-3]** states that, “Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established.” As such a precipitated calcium carbonate has been rendered obvious, such properties would necessarily follow by the combination of Kurata and Nishijima. This is also supported by evidentiary document Haenen, which discloses precipitated calcium carbonate having the claimed diameters also having the claimed BET specific surface areas and pore volumes (**paragraph 0019**).

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With respect to claims 5 and 8-9, as both Kurata and Nishijima are drawn to the production of coated paper with a coating composition based on precipitated calcium carbonate (**Kurata, abstract, claim 1, and Nishijima, abstract, claim 1**), it follows that the precipitated calcium carbonate can be considered a filler for the loading paper.

With respect to claims 6-7, as both Kurata and Nishijima are drawn to the production of coated paper with a coating composition based on precipitated calcium carbonate (**Kurata, abstract, claim 1, and Nishijima, abstract, claim 1**), it follows that the precipitated calcium carbonate can be considered a filler for the loading paper, and finally, that both references disclose the loaded paper product.

Response to Arguments

6. Applicant's arguments filed on May 3rd, 2010 have been fully considered but they are not persuasive.

Firstly, claim 2 cannot and will not be rejoined, as such an amendment merely creates a faux dependency to claim 1, and such a claim (claim 2) is still patentably distinct from the currently-examined invention and restrictable on the basis of belonging in different statutory classes as presented previously. Claims 6-7 have been examined and are rejected above.

With regards to applicant's argumentation, such grounds are muddled and not persuasive. Essentially, with applicant's amendment to the claim set clarifying such argumentation, the issue is of primary vs. secondary particles. However, applicant is claiming precipitated calcium carbonate having a secondary particle consisting of primary particles of spindle-shaped calcium carbonate. Although applicant attempts to describe what the crux of the instant invention is, examiner maintains that such a description is not commensurate with what is actually claimed,

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i.e. the breadth and ambiguity of instant claim 1. Regardless, the currently-cited references still recite spindle-shaped precipitated calcium carbonate having some average particle diameter in a secondary particle shape, and thus, examiner maintains such a teaching sufficiently reads upon the claim language of claim 1. Applicant's argumentation on the production of the calcium carbonate particles is not persuasive, as the instantly examined invention is drawn to the product, not the process of making. Finally, applicant argues the instant invention with respect to an aggregate. However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., aggregates) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thus, on the whole, applicant's argumentation is not persuasive.

Conclusion

7. Claims 1 and 3-9 are rejected.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph V. Micali whose telephone number is (571) 270-5906.

The examiner can normally be reached on Monday through Friday, 7:30am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry A. Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph V Micali/
Examiner, Art Unit 1793

/J.A. LORENZO/
Supervisory Patent Examiner, Art Unit
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